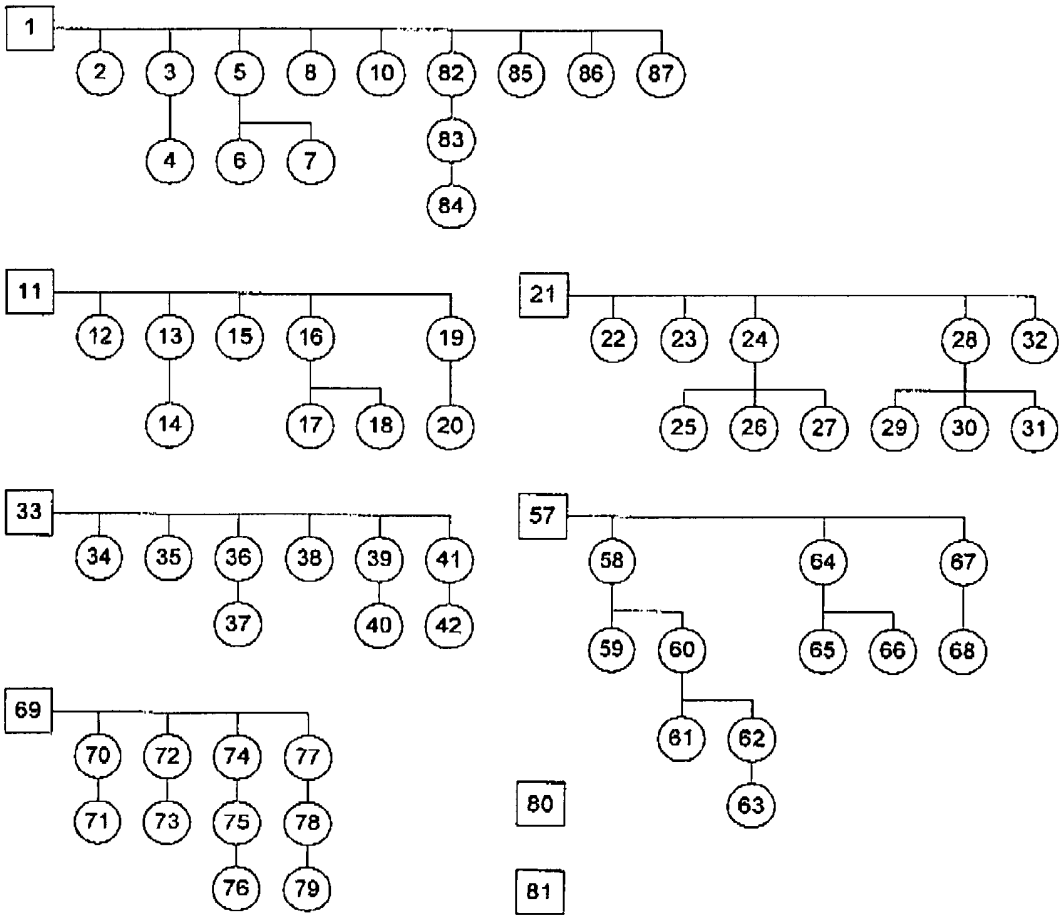
In re Application of LISITSA et al.
Application No. 09/310,596

REMARKS

Reconsideration of the application is respectfully requested. An Office action mailed April 23, 2004 is pending in the application. Applicants have carefully considered the Office action and the references of record. In the Office action, claims 1-8, 10-42 and 57-81 were rejected under 35 U.S.C. § 103, and claims 1-8, 10-42, 80 and 81 were further rejected on nonstatutory double patenting grounds. In this response to the Office action, claims 1, 11, 21, 33, 57, 69, 80 and 81 have been amended, and claims 82-87 have been added. Therefore, claims 1-8, 10-42 and 57-87 are pending in the application. The following diagram depicts the relationship between the independent and dependent claims.



In re Application of LISITSA et al.
Application No. 09/310,596

Rejections Under 35 U.S.C. § 103 of the Independent Claims

Each of the independent claims 1, 11, 21, 33, 57, 69, 80 and 81 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,086,628 to Dave et al. (hereinafter *Dave*) in view of U.S. Patent No. 5,282,202 to Bernstein et al. (hereinafter *Bernstein*). The Manual of Patent Examining Procedure (M.P.E.P.) states that, to support the rejection of a claim under 35 U.S.C. § 103(a), each feature of each rejected claim must be taught or suggested by the applied prior art.

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. ... "All words in a claim must be considered in judging the patentability of that claim against the prior art."

(M.P.E.P. § 2143.03). Each of the independent claims 1, 11, 21, 33, 57, 69, 80 and 81 as amended herein include at least one feature not taught or suggested by *Dave* or *Bernstein* alone or in combination and thus is patentable for at least this reason.

In particular, each of the independent claims 1, 11, 21, 33, 57, 69, 80 and 81 is amended herein to clarify the nature of composite frames in embodiments of the invention, including the relationship between composite frames and subframes. For example, claim 1 as amended requires that each composite frame includes nested subframes.

> Each composite frame comprising nested subframes.

(Claim 1 as amended). A composite frame in an embodiment of the present invention is a frame within which other frames may be nested. A subframe is a frame that may be nested within another frame.

> The term "composite frame" refers to a frame that has or may have other frames nested within it. A "subframe" is a frame that is or may be nested within another frame.

(Specification page 10, lines 21-23). Subframes may be nested within subframes as depicted in the example frame nestings in Figure 4B, Figure 5B and Figure 5D of the present application. Each of the independent claims 11, 21, 33, 57, 69, 80 and 81 includes corresponding clarifying amendments with respect to composite frames and subframes. Neither *Dave* nor *Bernstein*, nor any of the prior art of record, alone or in combination, teaches composite frames and subframes as claimed. It follows that the rejection under 35 U.S.C. § 103(a) of claims 1, 11, 21, 33, 57, 69, 80 and 81 should be withdrawn.

Independent Claim Rejections On Nonstatutory Double Patenting Grounds

Each of the independent claims 1, 11, 21, 33, 80 and 81 were further rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-24 of commonly owned U.S. Patent Application No. 09/310,610 (hereinafter application '610). The M.P.E.P. states that the reasoning supporting an obviousness-type double patenting rejection parallels the reasoning used to support a rejection under 35 U.S.C. § 103(a).

> The analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection.

(M.P.E.P. § 804, paragraph II.B.1). Application '610, alone or in combination with the prior art of record, fails to teach or suggest composite frames and subframes as claimed. It follows that, for at least this reason, the obviousness-type double patenting rejection of claims 1, 11, 21, 33, 80 and 81 should also be withdrawn.

Newly Added Claims

Claims 82-87 have been added in this amendment to more particularly point out and distinctly claim the invention as described by the specification. In compliance with 37 C.F.R. § 1.121(f), they do not add new matter.

The Remaining Dependent Claims

Each of claims 1, 11, 21, 33, 57, 69, 80 and 81 is in independent form, whereas all of the remaining claims depend directly or indirectly on one of these eight independent claims. The dependent claims are allowable for at least the same reasons that the eight independent claims 1, 11, 21, 33, 57, 69, 80 and 81 are allowable in that the dependent claims incorporate the features of the independent claims. Nevertheless, the dependent claims further define subject matter not shown or rendered obvious by the prior art of record. Because the independent claims are allowable over the applied prior art, applicants do not believe remarks addressing this further subject matter are necessary herein.

In re Application of LISITSA et al.
Application No. 09/310,596

CONCLUSION

The application is considered in good and proper form for allowance, and the examiner is respectfully requested to pass this application to issue. If, in the opinion of the examiner, a telephone conference would expedite the prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,

Richard P. Dodson, Reg. No. 52,824
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: July 23, 2004